



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Gong et al.

Serial No.: 10/605,708

Filed: October 21, 2003

For: CHIMERIC GENE CONSTRUCTS FOR
GENERATION OF FLUORESCENT
TRANSGENIC ORNAMENTAL FISH

Group Art Unit: 1632

Examiner: Singh, Anoop Kumar

Atty. Dkt. No.: GLOF:007USD1

Confirmation No: 2707

DECLARATION OF ZHIYUAN GONG

I, Zhiyuan Gong, declare as follows:

1. I am a joint inventor of the subject matter disclosed and claimed in the referenced application. I am currently a professor of Department of Biological Sciences, National University of Singapore, Singapore, and have previously made my *curriculum vitae* of record in the referenced prosecution. Unless otherwise indicated, I have personal knowledge of the facts recited hereinbelow.

2. I understand that the PTO examiner has recently cited the document CHAN Chiew Hua, "Isolation of Myosin Light Chain Promoter using Linker-Mediated PCR," thesis submitted in partial fulfillment for the degree of Bachelor of Science with Honours in Cell and Molecular Biology, Departments of Botany & Zoology, National University of Singapore, 1995/96" (document C89), in the prosecution of the referenced patent application. Additionally

submitted to the patent office (but I understand not relied upon by the examiner), was the reference of TIAN Ho Lian, "Functional Analysis of a Skeletal Muscle-Specific Promoter in Zebrafish," thesis submitted to the School of Biological Sciences, National University of Singapore, 1996/97 (document C90).

3. The authors of documents C89 and C90 were students in my laboratory enrolled in the Undergraduate Honors Program at the National University of Singapore. The Undergraduate Honors Program is one to which undergraduate students may apply after they have completed 3 years of study, and consists of approximately 70% course work and 30% research. More specifically, the first semester of the program consists exclusively of course work and in the second semester, in addition to some further course work, the students are required to conduct research and write a lengthy report on their research. Documents C89 and C90 are examples of such reports, that reflect the result of studies conducted by two such Honors Program students that worked in my laboratory under my direction and control.

4. I am familiar with departmental practice and pursuant to such practice, neither document C89 nor C90 would have been transmitted to the National University of Singapore library or to third parties outside of the department. While our department at one time had (but no longer has) a departmental reading room where documents such as C89 or C90 might have been shelved, our department does not maintain a departmental library, nor does it maintain a card catalogue or any other index of such documents.

5. I visited the National University of Singapore library in 2009 and confirmed that neither document C89 nor C90 was listed in the library card catalogue, and I was unable to otherwise find either document in the library.

6. I further understand that the PTO examiner has requested a more detailed explanation of my discussions with Dr. Hitoshi Okamoto, referenced in the emails attached as Exhibit 1.

7. On November 30, 2007, I had a telephone discussion with Dr. Okamoto. During that discussion we talked about a visit that he and I had had several years previously when he visited our aquarium and saw the transgenic fluorescent fish described in the referenced patent application. During that visit, Dr. Okamoto commented how, in contrast to our fish, the fish described in his publication (Higashijima *et al.*, *Dev. Biol.*, 192:289-299, 1997) did not display a visible fluorescence under normal daylight. He specifically stated to me that no visible fluorescent color could be seen under normal daylight in the adult green fluorescent protein-expressing fish described in the referenced Higashijima *et al.* article. During the November 30, 2007 telephone discussion he confirmed this to be the case.

8. I hereby declare that all statements made of my own knowledge are true and all statements made on information are believed to be true and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this application or any patent issued thereon.

____ March 31, 2010 ____
Date

____/Zhiyuan Gong/____
Zhiyuan Gong